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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/151,666	09/11/1998	WILLIAM M. SEAL	BS100/177618	8180

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 08/30/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/151,666

Applicant(s)

SEAL ET AL.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-4 are presented for examination.

Drawings

2. The drawings are objected to for the reasons identified in the attached Notice of Draftperson's Patent Drawing Review (Form PTO 948). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

Fig. 1 -- Reference Numbers 22, 24, 25, 32, 45, 51, 53, 54, 56, 60, 63, 68, 70

Fig. 2B -- Reference Number 125

Fig. 3 -- Reference Numbers 154, 160, 161

Fig. 5A -- Reference Number 203

Fig. 7 -- Reference Number 312

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities:

(a) Acronyms should be written out fully, at least the first time they appear in the specification, in order to clarify what the acronyms truly refer to. For example, the following acronyms have not been adequately identified in the specification: BCAS (first appears on page 10), REGIS (first appears on page 11), CAPRI (first appears on page 11), CAS/CATEWAY (first appears on page 12), LMOS (first appears on page 12).

(b) The Applicant is reminded that although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Please appropriately identify all trademarks, if any, that appear

in the specification. All trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

(c) The Applicant makes reference to an appendix in the following lines of the specification:

Page 13, lines 10-11, 18-19

Page 16, lines 2-3

Page 17, lines 5-6, 16-17

Page 20, lines 3-4

Page 24, lines 8-9

Page 25, lines 10-11

Page 26, lines 3-4

Page 27, lines 13-14

Page 28, lines 3-4

Applicant is reminded that appendices are limited to computer program listings; therefore, the present appendix is improper. Applicant has the option of incorporating the subject matter disclosed in the currently labeled "Appendix" into the specification and/or drawings (and correcting any present references to an appendix accordingly). Otherwise, this subject matter must be deleted since it does not qualify as a proper appendix. If the first option is chosen, Applicant is respectfully reminded to adhere to the requirements of a proper specification and drawings, including those set forth in 37 C.F.R. §§ 1.52, 1.58, and 1.84.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1 and 4 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for every conceivable means for achieving each of the recited applications. While claims 1 and 4 do not explicitly recite "means-plus-function" language, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use "means-plus-function" language. Similarly, instant claims 1 and 4 comprise "at least one of" various applications and each claim therefore invokes claim coverage for a system that includes only one of the recited applications, thereby making claims 1 and 4 analogous to single means claims. This parallels the fact situation in *Fiers* wherein "a DNA" and a result were recited. The CAFC stated in *Fiers* at 1606, "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived." See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous to single *means* claims even though "means" was not literally used. Consequently, claims 1 and 4 are held to be "nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor"

(MPEP 2164.08(a), making reference to *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983)).

Appropriate correction is required.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that they fail to point out what is included or excluded by the claim language. The body of claim 1 merely recites "at least one application for performing at least one of the actions described above." The body of claim 2 merely recites "at least one of the actions described above." Similarly, the body of claim 3 recites "at least one of the actions described above." These claims are omnibus type claims. See MPEP § 2173.05(r). For examination purposes, claims 1-3 will not specifically be treated on the basis of their merits; however, the Applicant is respectfully advised to look towards the rejection of claim 4 for references that are deemed to be relevant to the overall invention disclosed in Applicant's entire specification and therefore applicable to claims 1-3 as well.

Appropriate correction is required.

11. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are the interrelationships

among the recited applications. Not only does claim 4 cover a system including one of the recited applications, but it also seeks coverage for a system including anywhere from two to all of the recited applications. Therefore, an interrelationship among all of the claimed applications must be accounted for in the claim language itself.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1 and 4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As presently recited, the applications recited in claims 1 and 4 are deemed to be computer programs *per se* since it is not clear that these applications are computer readable instructions embodied on a computer readable medium. Computer programs *per se* are interpreted as functional descriptive material since "[s]uch claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer's functionality to be realized." (MPEP § 2106(IV)(B)(1)(a)) Consequently, claims 1 and 4 are deemed to be directed to non-statutory subject matter.

Appropriate correction is required.

Multiple art rejections have been warranted due to the breadth of the claims. Applicant is reminded that claims 1-3 will not specifically be treated on the basis of their merits; however, the Applicant is respectfully advised to look towards the rejection of claim 4 for references that are deemed to be relevant to the overall invention disclosed in Applicant's entire specification and therefore applicable to claims 1-3 as well. Also, please note that the "job entry other application" recited in claim 4 is interpreted as an application used to "automatically authorize and approve contractor work tasks," as explained on page 24 (lines 9-10) of the specification.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

15. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Pray et al. (U.S. Patent No. 4,885,694).

Pray discloses a system for performing job management, the system including at least one of:

- a regional contracts application;
- a bid and award application;
- a job entry application;
- a pricing application;
- a scheduling application;
- a materials management application;
- a job entry other application;
- a billing and reporting application;
- an inspections application;
- a workstation application; and

a management reports application (see at least Figs. 1, 8, 10a, 10b; col. 2, line 46 through col. 3, line 22; col. 9, lines 7-9; col. 16, lines 46-64; col. 17, line 62 through col. 18, line 2 – Note: Only one of the claimed applications needs to be anticipated by the prior art rejection under 35 U.S.C. 102 due to the recited “at least one of” language preceding the claimed list of applications; however, the cited reference anticipates multiple claimed applications).

16. Claim 4 is rejected under 35 U.S.C. 102(e) as being anticipated by Dudle et al. (U.S. Patent No. 5,570,291).

Dudle discloses a system for performing job management, the system including at least one of:

- a regional contracts application;
- a bid and award application;
- a job entry application;
- a pricing application;
- a scheduling application;
- a materials management application;
- a job entry other application;
- a billing and reporting application;
- an inspections application;
- a workstation application; and

a management reports application (see at least Figs. 2-6; col. 7, lines 29-59; col. 8, lines 7-27; col. 12, line 66 through col. 13, line 17 – Note: Only one of the claimed applications needs to be anticipated by the prior art rejection under 35 U.S.C. 102 due to the recited “at least one of” language preceding the claimed list of applications; however, the cited reference anticipates multiple claimed applications).

17. Claim 4 is rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al. (U.S. Patent No. 5,923,552).

Brown discloses a system for performing job management, the system including at least one of:

- a regional contracts application;
- a bid and award application;
- a job entry application;
- a pricing application;
- a scheduling application;
- a materials management application;
- a job entry other application;
- a billing and reporting application;
- an inspections application;
- a workstation application; and

a management reports application (see at least col. 2, lines 26-34; col. 3, line 60 through col. 4, line 2; col. 7, line 55 through col. 8, line 14; col. 8, lines 25-63 – Note: Only one of the claimed applications needs to be anticipated by the prior art rejection under 35 U.S.C. 102 due to the recited “at least one of” language preceding the claimed list of applications; however, the cited reference anticipates multiple claimed applications).

18. Claim 4 is rejected under 35 U.S.C. 102(e) as being anticipated by LeVander (U.S. Patent No. 6,216,108 B1).

LeVander discloses a system for performing job management, the system including at least one of:

a regional contracts application;

a bid and award application;

a job entry application;

a pricing application;

a scheduling application;

a materials management application;

a job entry other application;

a billing and reporting application;

an inspections application;

a workstation application; and

a management reports application (see at least Figs. 3-5; col. 7, line 8 through col. 13, line 50 – Note: Only one of the claimed applications needs to be anticipated by the prior art rejection under 35 U.S.C. 102 due to the recited “at least one of” language preceding the claimed list of applications; however, the cited reference anticipates multiple claimed applications).

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Maruyawa et al. (JP 405250377A) – Discloses a scheduling system in a production planning environment.

“Advanced Project Management Cost Optimization” – Discloses a project management tool for scheduling, monitoring project progress, allocating resources, and assessing critical paths.

“Material Logistics System” – Discloses the integration of managing customer contracts, bidding, billing, scheduling, inventory, and materials into one system.

“BellSouth Selects Bentley and NetSpace Systems” – Discloses BellSouth’s Outside Plant Construction Module (OSPCM), which is the subject of the present application. BellSouth is the assignee of the instant application, yet it should be noted that this article is dated less than a year prior to Applicant’s priority date; therefore, no issue of a statutory bar due to public use or sale is raised.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

Art Unit: 3623

***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.

Susanna M. Diaz

Susanna M. Diaz
Patent Examiner
Art Unit 3623
August 27, 2002